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FAX

Date:

February 27, 2003

Pages (including cover): 5

To:

Examiner Joseph T. Woitach

Fax: 1.703.305-3014

Ph: 1.703.305-3732

From:

Message:

Ronald I. Eisensetin

Applicants: Marasco et al.

FAX RECEIVED

OFFICIAL FEB 28 2003

Filed: March 24, 1997

Appln. No.: 08/822,033

GROUP 1600 For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND USE

### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown

Melissa Kruggel

Date: February 27, 2003

Date:

February 27, 2003

Pages (including cover): 5

To:

Examiner Joseph T. Woitach

Fax: 1.703.305-3014

Ph: 1.703.305.3732

From:

Ronald I. Eisenstein

Client/Matter:

700157-043471

User No.:

Disbursement Amount: \$



#### Practitioner's Docket N . 43471-RCE2

**PATENT** 

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Marasco et al.

Application No.:

08/822,033

Group No.: 1632

Filed:

03/24/1997

Examiner: Woitach, Joseph T.

For:

NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND

Commissioner for Patents and Trademarks Washington, D.C. 20231

#### REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION, OR IN THE ALTERNATIVE CONDITIONAL PETITION FOR WITHDRAWAL OF FINALITY

Applicants respectfully submit that the finality of the Office Action dated February 11, 2003 was improper and should be withdrawn, for the following reasons:

- On May 28, 2002, a Final Office Action was mailed in the parent application 1. (serial number 08/822,033, filed March 24, 1997).
- On October 28, 2002, applicants filed an Amendment after Final Rejection Under 2. 37 C.F.R. 111.6, and Petition or Extension of Time.
- 3. On November 18, 2002, an Advisory Action (paper no. 40) was mailed, indicating that the proposed Amendment would not be entered because it raised new issues that would further consideration and/or search [copy attached hereto].
- 4. Accordingly, on November 26, 2002, applicants filed an RCE application, including the previously submitted Amendment and the requisite fee.

#### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown below.

Melissa Kruggel

Date: February 27, 2003

- On February 11, 2003 in response to the filing the RCE, a Final Office Action was mailed, indicating that the application was eligible for continued examination under 37 C.F.R. 1.114, and that the proper fee had been paid. The Examiner entered the Amendment filed November 26, 2002, but made the Office Action "final".
- 6. MPEP 706.07(h), Section VIII, sets forth the conditions required for issuing a First Action Final After Filing an RCE, stating in relevant part: "The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § [emphasis added]
- 7. MPEP § 706.07(b) explicitly states "it would <u>not</u> be proper to make final a first Office action in a continuing or substitute application where that material which was presented in the earlier application after final rejection ... was denied entry because (A) new issues were raised that required further consideration and/or search..." [emphasis added]
- 8. That is precisely the situation that has occurred here.
- Accordingly, applicants respectfully submit that the finality of the Office Action dated February 11, 2003, was not proper, and respectfully request its withdrawal.
- 10. In the event that the Examiner does not grant this request to withdraw the finality of the Office Action, please consider this a Petition Under 37 CFR 1.181 to the Commissioner to withdraw finality due to prematureness of final rejection, MPEP § 706.07(c). (See MPEP § 1002(02)(c)(3)(a).) The Commissioner is authorized to charge any fee due in connection with this petition to Deposit Account No. 50-0850.
- 11. Applicants believe no fee is due. However, please charge any required to Deposit Account No. <u>50-0850</u>

Reg. No.: 30,628

Tel. No.: 617-345-6054

Customer No.: 26248

Ronald I. Eisenstein NIXON PEABODY LLP

101 Federal Street Boston, MA 02110





## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20201

APPLICATION NO.			Washington, D.C. 20231	ATENTS AND TRADEMARKS
	FILING DATE	FIRST NAMED INVENTOR		
08/822,033	03/24/1997		ATTORNEY DOCKET NO.	CONFIRMATION NO.
75		WAYNE A. MARASCO	43471-5WC RCE	5884
Ronald I. Eiser NIXON PEABO 101 Federal Stre	DYLLP		EXAMI	VER
Boston, MA 02	110		WOITACH, J	OSEPH T
		·	ART UNIT	PAPER NUMBER
			1632	
			DATE MAILED: 11/18/2002	σIJ

Please find below and/or attached an Office communication concerning this application or proceeding.

NIXON PEABODY LLP

- The MAILING DATE of this communication appears of THE REPLY FILED Nov 4, 2002 FAILS TO PLACE TO Therefore, further action by the applicant is required to avoid rejection under 37 CFR 1.113 may only be either: (1) a time allowance; (2) a timely filed Notice of Appeal (with appeal for RECE) in compliance with 37 CFR 1.114.  THE PERIOD FOR RECE THE BOX WHEN THE FIRST IN Sea MPEP 706.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a). The determining the period for reply expires on: (1) the mailing date of this is later. In no event, however, will the statutory period for final rejection. ONLY CHECK THIS BOX WHEN THE FIRST IN Sea MPEP 706.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a). The determining of the final rejection, even if timely filed, may reduce a appropriate extension fee under 37 CFR 1.17(a) is calculated from: set in the final Office action; or (2) as act forth in (b) above, if check mailing date of the final rejection, even if timely filed, may reduce a set in the final Office action; or (2) as act forth in (b) above, if check mailing date of the final rejection, even if timely filed, may reduce a set in the final office action; or any extension thereof (37 CFR 1.192(a), or any extension thereof (37 CFR 1.20).  The proposed amendment(s) will not be entered because (a) they raise new issues that would require further condition they raise the issue of new matter (see NOTE below they are not deemed to place the application in better issues for appeal; and/or (d) they present additional claims without canceling a condition of the proposed means limitations requires a new NOTE: The pro	d the abandonment of the abandonment of the amendment of the period of extens (1) the period of extens (1) the expiration date of the period of extens (1) the expiration date of the period of extens (1) the expiration date of expiration date of expiration date of expiration date (a), to avoid date (b), to avoid date (c), and the period of extens (1) the expiration date (a).	In CONDITION OF THE STATE OF TH	Art Unit 1632  pondence addre ON FOR ALLOV cation. A propes the application forth in the final reform the malling of NTHS OF THE FIN FR 1.138(a) and presponding amounted statutory period attention the period within the period appeal.  OTE below);	WANCE, per reply to a on in condition Examination Examination the factor of the factor
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Newly proposed	:			
Newly proposed or amended claim(s)				
a separate, timely filed amendment canceling the non-alle	wable claim(s).	would	d be allowable i	if submitted i
application in condition for allowance because: <u>Applicants' arguments are directed to claim amendments</u>	consideration has b which have not be	en entered.		
The affidavit or exhibit will NOT be considered because it by the Examiner in the final rejection.	is not directed SO	LELY to issue	es which were	newly raised
explanation of how the new or amended claims would be				an
Claim(e) alleged		0, 45	-poriueu,	
Claim(s) objected to:				
Claim(s) rejected: 1 and 3 16				
Claim(s) withdrawn from considerations				
Claim(s) withdrawn from consideration:  The proposed drawing correction filed on				
The proposed drawing correction filed on  Note the attached Information Disclosure Statement(s) (PTO)  Other:	is all approv	ved or b∏ c	disapproved by	the Examine

PRIMARY EXAMINER

GROUP 18007